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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/564,056

01/10/2006

Hiroyuki Okada

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EXAMINER

MOORE, MARGARET G

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

11/24/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/564,056	<b>Applicant(s)</b> OKADA ET AL.	
	<b>Examiner</b> Margaret G. Moore	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 to 5, 7, 8, 10 to 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 to 5, 7, 8, 10 to 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 to 5, 7, 8 and 10 to 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amagai et al. '307.

The teachings of Amagai et al. were noted in the previous office action and as such this will not be repeated. Applicants' have amended their claims to include a silicone oil having a particular structure, as shown in claim 1. This does not overcome the obviousness of the claims over the teachings of Amagai et al. While the prior art does not specifically teach a modified silicone oil having the structure as shown, one having ordinary skill in the art would have found such a silicone oil to have been obvious over the teachings found in Amagai et al.

As noted previously, column 15, lines 15 and on, in Amagai et al. teach the addition of non-ionic surfactants or polysiloxanes as mold release agents. While Amagai et al. do not specifically teach a silicone oil meeting the claimed structure, considering the level of skill of one having ordinary skill in the silicone art, the skilled artisan would have found such silicone oils to have been obvious. Rather than relying on specific secondary references for this rejection, the Examiner is basing the position of obvious on that which would have been known in the art. As exemplified by the various and non-limiting references cited below, it is known in the art that polysiloxane release agents will meet the structure of silicone oils as claimed.

5,599,778 which teaches mold release agents which include silicone oils meeting each of the formula shown when X is methyl.

4,477,366 in which various internal mold release agents on columns 5 and 6 are shown meeting the formula shown when X is polyether. See also column 6, lines 25 and on, which shows a structure for a silicone surfactant used in a release composition that meets the formulas in claim 1.

5,043,409, column 6, which shows various release agents which meet the formula shown when X is a long chain hydrocarbon.

5,428,092 which shows various polydimethylsiloxanes as components in release agents.

5,486,322, which defines release agents on column 10, lines 35 and on, and include polydimethylsiloxanes meeting the formula shown when X is methyl.

These references are representative of that which is known in the art, that is, that silicone oils falling within the breadth of claimed component (C) are well known in the silicone art to function as release agents.

In addition the Examiner notes that while Amagai et al. generally teach "polysiloxane", the skilled artisan would recognize that dimethyl substituted (i.e. meeting the claimed silicone oil when X is methyl) is the most basic and common polysiloxane available. Upon reading "polysiloxane" in Amagai et al. one would have immediately envisioned the most basic and common type of polysiloxane, a polydimethylsiloxane.

Thus one having ordinary skill in the art, in view of the teachings in Amagai et al. that non-ionic silicone surfactants or polysiloxane can be added to the composition in an effort to obtain internal mold release properties, would have been motivated to select a known and conventional silicone release agents. As the Examiner has established, it is well known that such silicone release agents include polydimethylsiloxanes and many other silicone oils that fall within the breath of the formulas shown in newly amended (C). As such one having ordinary skill in the art would have found the selection of a silicone oil meeting (C) to have been obvious. In this manner the instant claims are rendered obvious over the teachings of Amagai et al.

For newly amended claims 11 to 13, note column 2, lines 15 and on, which refer to adjusting thickness to provide practical strength. One having ordinary skill in the lens art would have been motivated to adjust the thickness of the lenses in Amagai et al. in an effort to determine the optimal strength and impact resistance of the resulting lens. In this manner one having ordinary skill in the art would have found a thickness within the claimed ranges to have been obvious.

Applicants' traversal is not persuasive. While applicants argue improved wetting while the prior art adds the polysiloxanes as a mold release agent, the Examiner notes that a *prima facie* case of obviousness (for a composition) does not require the solution of the same problem or recognition of the same advantages as the applicants invention. In *re* Dillon 16 USPQ2d 1897 (CAFC, en banc, 1990), which overrules In *re* Dillon 13 USPQ 2d 1337 and In *re* Wright 6 USPQ 2d 1959. The Examiner has shown that the modified silicone oils as claimed are known to function as release agents. This amendment is not sufficient to establish any unobviousness to the claims.

3. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Amagai et al. as applied to claims 1 to 5, 7, 8, 10 to 14 above, and further in view of Okazaki et al. '738, Okazaki et al. '747 or Sakagami et al.

The teachings of Amagai et al. do not include the addition of a filler.

The addition of a filler to optical lens compositions as a common additive is known in the art. See for instance column 5, lines 54 to 62 in '747, column 11, line 56, in '738 and column 6, line 38 in Sakagami et al. The addition of fillers is known to modify the properties of the resulting lens in a predictable and adjustable manner. Such fillers are common additives.

It is prima facie obvious to add a known ingredient to a known composition for its known function. One having ordinary skill in the art would have found the addition of a common additive such as a filler to the composition of Amagai et al. to have been obvious in an effort to adjust and/or optimize the properties of the resulting lens composition.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Margaret G. Moore/  
Primary Examiner, Art Unit 1796

mgm  
11/21/08